

Appl. No. 10/016,051
Amdt. Dated August 25, 2003
Reply to Office Action of May 23, 2003

• • REMARKS/ ARGUMENTS • •

The Official Action of May 23, 2003 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

On pages 2 and 3 of the Official Action the Examiner has made of record an Election of Species of Requirement and applicant's election to prosecute the species of the invention directed to an absorbent article comprising skin-contactable sheets which are elastically stretchable in the present application.

Applicant hereby affirms his election to prosecute the species of the invention directed to an absorbent article comprising skin-contactable sheets which are elastically stretchable in the present application and that claims 1-4 read on this species.

By the present amendment, claim 5 which was directed to a non-elected species of the invention has been cancelled without prejudice or disclaimer.

Applicant reserves his right to seek patent protection for the non-elected species of the invention by filing and prosecuting a divisional application during the pendency of the present application.

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By the present amendment, the title of the invention as been changed to: DISPOSABLE DIAPER WITH SKIN-CONTACTABLE SHEETS SPACED ABOVE SKIN CONTACTABLE SURFACE.

This change in title, which is believed to be more descriptive of applicant's claimed invention and as been submitted in response to the Examiner's request for applicant to submit a new title which is more descriptive of applicant's invention.

Also by the present amendment, the limitations of claims 2 and 3 have been incorporated into independent claim 1.

The changes to independent claim 1 include the recitation that the liquid-absorbent panel is positioned between the skin-contactable surface and the non skin-contacting surface. This change to claim 1 addresses and overcomes the outstanding rejections of claims 1-4 under the first and second paragraphs of 35 U.S.C. §112.

Entry of the changes to the title of the invention and the changes to the claims is respectfully requested.

Claims 1 and 4 are pending in this application.

Claims 1-4 were previously rejected under 35 U.S.C. §112, first paragraph. Under this rejection the Examiner noted that claim 1 recited that the liquid-absorbent panel was attached to the base sheet and lies on the skin-contactable sheet. The Examines pointed out that this limitation contradicted the disclosure because Fig. 4 shows the liquid-absorbent panel as being juxtaposed on

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the non skin-contactable surface with the skin-contactable surface being located on the liquid-absorbent panel.

In response to this rejection, as noted above, independent claim 1 has been changed to recite that the liquid-absorbent panel is positioned between the skin-contactable surface and the non skin-contacting surface.

This change to independent claim 1 is believed to address and overcome the outstanding rejection of the pending claims under 35 U.S.C. §112, first paragraph.

Claims 1-4 were further rejected by the Examiner under 35 U.S.C. §112, second paragraph. The Examiner's stated basis for this rejection are essentially the same as the basis for the rejection of the claims under 35 U.S.C. §112, first paragraph.

Accordingly the amendments made herein for independent claim 1 are believed to further address and overcome the rejection of the claims under 35 U.S.C. §112, second paragraph.

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by European Patent Application No. 0 955 038 to Mishima et al.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mishima et al. in view of U.S. Patent No. 6,120,488 to Van Rijswijck et al.

On page 3 of the Official Action the Examiner indicated that claim 3 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112 and to include all the limitations of the base and any intervening claims.

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By the present amendment, the limitations of claims 2 and 3 have been essentially incorporated into independent claim 1. For example, as per previous dependent claim 2, independent claim 1, as amended herein, now recites a pair of skin-contactable sheets which are spaced apart.

Also, independent claim 1, as amended herein, now recites the features of the liquid-impervious leak-barrier cuffs which were previously found in dependent claim 3.

It is submitted that independent claim 1 is presently allowable inasmuch as claim 1 now presents the limitations of claim 3 in independent form, and the Examiner indicated that such an independent claim would be allowed.

Claim 4 stands free of a prior art rejection.

Because the Examiner has indicated that the limitations of claim 3 are directed to allowable subject matter, no comments concerning the relevance of the prior art of record are deemed necessary in the present response.

There appears to be some contradiction to the fact that the Examiner has both rejected claim 3 under 35 U.S.C. §103(a) and indicated that claim 3 would be allowable if rewritten in independent form.

This apparent contradiction is resolved by noting that in the rejection claim 3 under 35 U.S.C. §103(a) the Examiner relied upon Van Rijswijck et al. as teaching a nonwoven material which the Examiner stated would have been obvious to use for the barrier cuffs of Mishima et al.

This indicates that the Examiner actually relied upon Van Rijswijck et al. to reject claim 4 since Mishima et al. does not teach and does not require the leak-barrier cuffs of applicant's claim 3.

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Note, the fact that the barrier cuffs 22 of Mishima et al. as attached to the side edges of the topsheet excludes the need for the leak-barrier cuffs of applicant's claim 3.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicant's claimed invention under 35 U.S.C. §102.

Moreover, the Examiner cannot properly rely upon the prior art under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejections of the claims and an early allowance of the claims is believed to be in order.


It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

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To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,


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